

ESTTA Tracking number: **ESTTA274409**

Filing date: **03/25/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	ShoreTel, Inc.
Granted to Date of previous extension	03/25/2009
Address	960 Stewart Drive Sunnyvale, CA 94085 UNITED STATES
Attorney information	Hoang-chi Truong, Esq. Fenwick & West LLP 801 California Street Silicon Valley Center Mountain View, CA 94041 UNITED STATES trademark@fenwick.com Phone:650-988-8500

Applicant Information

Application No	77434657	Publication date	11/25/2008
Opposition Filing Date	03/25/2009	Opposition Period Ends	03/25/2009
Applicant	ShoreGroup, Inc. 460 West 35th Street New York, NY 10001 UNITED STATES		

Goods/Services Affected by Opposition

Class 037. First Use: 2001/04/01 First Use In Commerce: 2001/07/01 All goods and services in the class are opposed, namely: Computer support services, namely, maintenance of computer hardware that perform network management, network fault detection, and network problem tracking and resolution
Class 042. First Use: 2001/04/01 First Use In Commerce: 2001/07/01 All goods and services in the class are opposed, namely: Computer support services, namely, monitoring of network systems and maintenance of computer software that perform network management, network fault detection, and network problem tracking and resolution

Applicant Information

Application No	77434589	Publication date	11/25/2008
Opposition Filing Date	03/25/2009	Opposition Period Ends	
Applicant	ShoreGroup, Inc. 460 West 35th Street New York, NY 10001		

	UNITED STATES
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Goods/Services Affected by Opposition


Class 037. First Use: 2003/05/00 First Use In Commerce: 2003/05/00 All goods and services in the class are opposed, namely: Computer services, namely, maintenance services in the fields of local and wide area networks (LAN/WAN), Internet Protocol Telephony and the field of Internet Protocol Contact Centers
Class 042. First Use: 2003/05/00 First Use In Commerce: 2003/05/00 All goods and services in the class are opposed, namely: Computer services, namely, technical monitoring services for others in the fields of local and wide area networks (LAN/WAN), Internet Protocol Telephony and the field of Internet Protocol Contact Centers


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2803949	Application Date	09/26/2000
Registration Date	01/13/2004	Foreign Priority Date	NONE
Word Mark	SHORELINE		
Design Mark			
Description of Mark	The mark consists of a stylized "S" inside a shaded oval.		
Goods/Services	<p>Class 009. First use: First Use: 2000/02/17 First Use In Commerce: 2000/02/25 Computer hardware and computer software and manuals sold as a unit, for the management, administration, and control by others of telecommunications systems, private branch exchange systems or call distribution systems; telecommunication and communications switches, routers and servers</p> <p>Class 037. First use: First Use: 1999/09/22 First Use In Commerce: 1999/09/29 Installation for others of computer networks; maintenance for others of computer networks; repair of telecommunications systems; repair of computer networks; repair of communications systems; installation and maintenance for others of hardware for both telecommunications systems and communications systems</p> <p>Class 042. First use: First Use: 1999/09/22 First Use In Commerce: 1999/09/29 Technical support services, namely troubleshooting of problems with telecommunications systems, computer networks and communications systems for others via telephone, email and in person; telecommunications and computer services, namely the supervision and monitoring of telecommunications systems, private branch exchange systems, and call distribution systems</p>		
U.S. Registration No.	2551810	Application Date	04/11/2000

Registration Date	03/26/2002	Foreign Priority Date	NONE
Word Mark	SHORECARE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 1999/09/22 First Use In Commerce: 1999/09/29 Installation, maintenance and repair of telecommunications systems and computer networks Class 042. First use: First Use: 1999/09/22 First Use In Commerce: 1999/09/29 Installation, maintenance [and] * and * repair of computer software; technical support services, namely, troubleshooting of telecommunications systems, computer networks and computer software problems via telephone, e-mail, in person, and online		



U.S. Registration No.	2444417	Application Date	04/11/2000
Registration Date	04/17/2001	Foreign Priority Date	NONE
Word Mark	SHOREGEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2000/06/30 First Use In Commerce: 2000/06/30 telecommunications switches; computer hardware; computer communications switches		

U.S. Registration No.	2444415	Application Date	04/11/2000
Registration Date	04/17/2001	Foreign Priority Date	NONE
Word Mark	SHOREWARE		

Design Mark	SHOREWARE
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2000/02/17 First Use In Commerce: 2000/02/25 computer software and manuals sold as a unit, for the management, administration, or control of telecommunications systems, private branch exchange systems or call distribution systems

U.S. Registration No.	3521643	Application Date	05/30/2007
Registration Date	10/21/2008	Foreign Priority Date	NONE
Word Mark	SHOREPHONE		
Design Mark	SHOREPHONE		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2002/08/00 First Use In Commerce: 2002/08/00 Telephones, IP telephones, computer telephony software, and telephone apparatuses		

U.S. Registration No.	3230491	Application Date	11/26/2003
Registration Date	04/17/2007	Foreign Priority Date	NONE
Word Mark	SHORETEL		

Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2004/04/00 First Use In Commerce: 2004/04/00 Computer hardware and computer software and manuals sold as a unit, for the management, administration, and control by others of telecommunications systems, private branch exchange systems or call distribution systems; telecommunication and communications switches, routers and servers; Computer software for installing telecommunications systems and for training others in the use and operation of telecommunications systems</p> <p>Class 037. First use: First Use: 2004/04/00 First Use In Commerce: 2004/04/00 Installation, maintenance and repair of telecommunications systems and computer networks; Installation, maintenance and repair for others of communications systems, telecommunications systems and computer networks; installation and maintenance for others of hardware for both telecommunications systems and communications systems</p> <p>Class 038. First use: First Use: 2004/04/00 First Use In Commerce: 2004/04/00 telecommunications services, namely the supervision and monitoring of telecommunication systems, private branch exchange systems, and call distribution systems</p> <p>Class 042. First use: First Use: 2004/04/00 First Use In Commerce: 2004/04/00 Installation, maintenance and repair for others of computer software; technical support services, namely troubleshooting of problems with telecommunications systems, computer networks, computer software, and communications systems for others via telephone, email, and in person; telecommunications computer services, namely, the supervision and monitoring of telecommunication systems, private branch exchange systems, and call distribution systems; installation and maintenance for others of software for both telecommunications systems and communication systems</p>		
U.S. Registration No.	3272772	Application Date	01/30/2004
Registration Date	07/31/2007	Foreign Priority Date	NONE
Word Mark	SHORETEL		
Design Mark			

Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 2004/04/00 First Use In Commerce: 2004/04/00 Computer hardware and computer software and manuals sold as a unit, for the management, administration, and control by others of telecommunications systems, private branch exchange systems or call distribution systems; telecommunication and communications switches, routers and servers; Computer software for installing telecommunications systems and for training others in the use and operation of telecommunications systems</p> <p>Class 035. First use: First Use: 2004/04/00 First Use In Commerce: 2004/04/00 Operation and administration of telecommunications systems, private branch exchange systems, and call distribution systems for others</p> <p>Class 037. First use: First Use: 2004/04/00 First Use In Commerce: 2004/04/00 Installation, maintenance and repair of telecommunications systems and computer networks; Installation, maintenance and repair for others of communications systems, telecommunications systems and computer networks; installation and maintenance for others of hardware for both telecommunications systems and communications systems</p> <p>Class 042. First use: First Use: 2004/04/00 First Use In Commerce: 2004/04/00 Installation, maintenance and repair for others of computer software; technical support services, namely troubleshooting of problems with telecommunications systems, computer networks, computer software, and communications systems for others via telephone, email, and in person; telecommunications computer services, namely the supervision and monitoring of telecommunication systems, private branch exchange systems, and call distribution systems; installation and maintenance for others of software for both telecommunications systems and communication systems</p>

Attachments	<p>76136589#TMSN.gif (1 page)(bytes) 76023794#TMSN.gif (1 page)(bytes) 76023908#TMSN.gif (1 page)(bytes) 76023632#TMSN.gif (1 page)(bytes) 77193661#TMSN.jpeg (1 page)(bytes) 78333874#TMSN.jpeg (1 page)(bytes) 78360260#TMSN.gif (1 page)(bytes) Shoregroup and Shorepatrol Consolidated Notice of Opposition.pdf (6 pages)(26218 bytes)</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/hoangchitruong/
Name	Hoang-chi Truong, Esq.
Date	03/25/2009

1. Opposer, Shoretel, Inc., a California corporation, having its principal place of business at 960 Stewart Drive, California 94085, believes it will be damaged by registration of the marks SHOREGROUP and SHOREPATROL shown in Application Nos. 77/434,657 and 77/434,589, respectively, and hereby opposes those applications, alleging as grounds for its opposition that:

2. As is evidenced by the publication of the proposed SHOREGROUP mark in the November 25, 2008, issue of the Official Gazette, Applicant, Shoregroup, seeks to register the mark SHOREGROUP as service mark for “computer support services, namely, maintenance of computer hardware that perform network management, network fault detection, and network problem tracking and resolution,” in International Class 37 and “computer support services, namely, monitoring of network systems and maintenance of computer software that perform network management, network fault detection, and network problem tracking and resolution,” in International Class 42. Applicant filed its SHOREGROUP application on March 28, 2008, alleging a date of first use of April 1, 2001, and a date of first use in commerce of July 1, 2001.

3. As is evidenced by the publication of the proposed SHOREPATROL mark in the November 25, 2008, issue of the Official Gazette, Applicant seeks to register SHOREPATROL as a service mark for “computer services, namely, maintenance services in the fields of local and wide area networks (LAN/WAN), Internet Protocol Telephony and the field of Internet Protocol Contact Centers,” in International Class 37 and “computer services, namely, technical monitoring services for others in the fields of local and wide area networks (LAN/WAN), Internet Protocol Telephony and the field of Internet Protocol Contact Centers,” in International Class 42. Applicant filed its SHOREPATROL application on March 28, 2008, alleging a date of first use and first use in commerce of May 2003.


4. Opposer is a leading provider of Internet Protocol (IP) unified communications solutions, enabling businesses to seamlessly integrate all communications – voice, data, and video – for their multiple sites in a single telecommunications system. Opposer’s communications system allows users to access and manage their voice communications from any desktop and provides them with automated answering and routing capabilities, among other things. Additionally, Opposer’s system makes it easy for administrators to manage an enterprise’s telecommunications systems because they can make changes to any site from one single, centralized point. Opposer’s solutions comprise switches, IP telephones, software applications, and design, installation, technical support, and training services, with its customers ranging from small, medium, and large companies to public institutions and governments.

5. Opposer owns the following SHORE-based trademark registrations on the Principal Register, which were filed prior to the filing dates of Applicant’s SHOREGROUP and SHOREPATROL applications:

Mark	Appln. No.	Reg. No.	Goods and Services	Status
Shoreline	76/136,589, filed Sept. 26, 2000	2,803,949, registered Jan. 13, 2004	Class 9: Computer hardware and computer software and manuals sold as a unit, for the management, administration, and control by others of telecommunications systems,	Registered

Mark	Appln. No.	Reg. No.	Goods and Services	Status
			<p>private branch exchange systems or call distribution systems; telecommunication and communications switches, routers and servers. First use: Feb. 17, 2000, and first use in commerce: Feb. 25, 2000.</p> <p>Class 37: Installation for others of computer networks; maintenance for others of computer networks; repair of telecommunications systems; repair of computer networks; repair of communications systems; installation and maintenance for others of hardware for both telecommunications systems and communications systems. First use: Sept. 22, 1999, and first use in commerce: Sept. 29, 1999.</p> <p>Class 42: Technical support services, namely troubleshooting of problems with telecommunications systems, computer networks and communications systems for others via telephone, email and in person; telecommunications and computer services, namely the supervision and monitoring of telecommunications systems, private branch exchange systems, and call distribution systems. First use: Sept. 22, 1999, and first use in commerce: Sept. 29, 1999.</p>	
SHORECARE	76/023,704, filed April 11, 2000	2,551,810, registered March 26, 2002	<p>Class 37: Installation, maintenance and repair of telecommunications systems and computer networks. First use: Sept. 22, 1999, and first use in commerce: Sept. 29, 1999.</p> <p>Class 42: Installation, maintenance and repair of computer software; technical support services, namely, troubleshooting of telecommunications systems, computer networks and computer software problems via telephone, e-mail, in person, and online. First use: Sept. 22, 1999, and first use in commerce: Sept. 29, 1999.</p>	Incontestable registration

Mark	Appln. No.	Reg. No.	Goods and Services	Status
SHOREGEAR	76/023,908, filed April 11, 2000	2,444,417, registered April 17, 2001	Class 9: Telecommunications switches; computer hardware; computer communications switches. First use and first use in commerce: June 30, 2000.	Incontestable registration
SHOREWARE	76/023,632, filed April 11, 2000	2,444,415, registered April 17, 2001	Class 9: Computer software and manuals sold as a unit, for the management, administration, or control of telecommunications systems, private branch exchange systems or call distribution systems. First use: Feb. 17, 2000, and first use in commerce: Feb. 25, 2000.	Incontestable registration
SHOREPHONE	77/193,661, filed May 30, 2007	3,521,643, registered Oct. 21, 2008	Class 9: Telephones, IP telephones, computer telephony software, and telephone apparatuses. First use and first use in commerce: August 2002.	Registered
SHORETEL	78/333,874, filed Nov. 26, 2003	3,230,491, registered April 17, 2007	<p>Class 9: Computer hardware and computer software and manuals sold as a unit, for the management, administration, and control by others of telecommunications systems, private branch exchange systems or call distribution systems; telecommunication and communications switches, routers and servers; computer software for installing telecommunications systems and for training others in the use and operation of telecommunications systems. First use and first use in commerce: April 2004.</p> <p>Class 37: Installation, maintenance and repair of telecommunications systems and computer networks; Installation, maintenance and repair for others of communications systems, telecommunications systems and computer networks; installation and maintenance for others of hardware for both telecommunications systems and communications systems. First use and first use in commerce: April 2004.</p> <p>Class 38: Telecommunications services, namely the supervision and monitoring of telecommunication systems, private branch exchange systems, and call distribution systems. First use and first use in commerce:</p>	Registered

Mark	Appln. No.	Reg. No.	Goods and Services	Status
			<p>April 2004.</p> <p>Class 42: Installation, maintenance and repair for others of computer software; technical support services, namely troubleshooting of problems with telecommunications systems, computer networks, computer software, and communications systems for others via telephone, email, and in person; telecommunications computer services, namely, the supervision and monitoring of telecommunication systems, private branch exchange systems, and call distribution systems; installation and maintenance for others of software for both telecommunications systems and communication systems. First use and first use in commerce: April 2004.</p>	
	78/360,260, filed Jan. 30, 2004	3,272,772, registered July 31, 2007	<p>Class 9: Computer hardware and computer software and manuals sold as a unit, for the management, administration, and control by others of telecommunications systems, private branch exchange systems or call distribution systems; telecommunication and communications switches, routers and servers; computer software for installing telecommunications systems and for training others in the use and operation of telecommunications systems. First use date and first use in commerce date: April 2004.</p> <p>Class 35: Operation and administration of telecommunications systems, private branch exchange systems, and call distribution systems for others. First use date and first use in commerce date: April 2004.</p> <p>Class 37: Installation, maintenance and repair of telecommunications systems and computer networks; installation, maintenance and repair for others of communications systems, telecommunications systems and computer networks; installation and maintenance for others of hardware for both</p>	Registered

Mark	Appln. No.	Reg. No.	Goods and Services	Status
			<p>telecommunications systems and communications systems. First use date and first use in commerce date: April 2004.</p> <p>Class 42: Installation, maintenance and repair for others of computer software; technical support services, namely troubleshooting of problems with telecommunications systems, computer networks, computer software, and communications systems for others via telephone, email, and in person; telecommunications computer services, namely the supervision and monitoring of telecommunication systems, private branch exchange systems, and call distribution systems; installation and maintenance for others of software for both telecommunications systems and communication systems. First use date and first use in commerce date: April 2004.</p>	

6. Said registered marks of Opposer are valid and subsisting and are prima facie evidence of Opposer's exclusive right to use the marks in commerce in connection with the goods and services identified therein.

7. Additionally, Opposer's use of a majority of its SHORE-based marks was prior to Applicant's alleged dates of first use of the SHOREGROUP and SHOREPATROL marks.

8. Opposer's SHORE-based marks have been extensively advertised and promoted in connection with Opposer's goods and services together in such a manner as to establish Opposer's SHORE-based marks as a family of marks, with SHORE being the family surname.

9. As a consequence of Opposer's extensive use and promotion of its SHORE-based marks in commerce, the SHORE-based marks have become well known in the telecommunications industry to identify Opposer's goods and services. As a result, Opposer's SHORE-based marks have become valuable assets of Opposer and principal symbols of its goodwill.

10. Given the similarity between Opposer's SHORE-based marks and Applicant's SHOREGROUP and SHOREPATROL marks and the similarity, overlapping and/or related nature of the parties' goods and services, Opposer hereby alleges that Applicant's marks so resemble Opposer's SHORE-based marks previously used in the United States, and not abandoned, as to be likely to cause confusion or to cause mistake or to deceive, and to dilute the value and the source identifying power of Opposer's marks, thereby causing loss, damage and injury to Opposer and the public.

11. Opposer requests that this be a consolidated opposition against Applicant's SHOREGROUP and SHOREPATROL marks because Opposer's claims against each application involve similar questions of law and fact.

12. Opposer prays that this Notice of Opposition be sustained, that Applicant's Trademark Application Nos. 77/434,657 and 77/434,589 be rejected, and that Applicant be denied registration of SHOREGROUP and SHOREPATROL as service marks for the services specified in those applications.

23215/00070/DOCS/2047056.1